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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,038	10/27/2003	Kevin T. O'Dougherty	N95.12-0015	3887

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EXAMINER
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PRICE, CRAIG JAMES

ART UNIT	PAPER NUMBER
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3753

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/694,038

Applicant(s)

O'DOUGHERTY ET AL.

Examiner

Craig Price

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-14,16-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) 3,5 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14,16-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 October 2006 has been entered.

### ***Election/Restrictions***

2. Species A remains the elected invention. Applicant has requested a switch the election to species B. The traversal is on the ground(s) that the species can be searched without a burden to the examiner, and refers to MPEP 819.01. This is not found persuasive because the MPEP section of 819, refers to a request for continued examination and there is no listing of 819.01 within the manual. The office does not permit a shift of election.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3,15,and 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5 April 2006.

This application contains claims 3,15 and 21 drawn to an invention nonelected with traverse in the paper filed on 5 April 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,4-12,14,16-20 and 22-24 rejected under 35 U.S.C. 102(b) as being unpatentable by Van den Bergen et al.(6,048,113).

Regarding claims 1 and 14, Van den Bergen et al. disclose a liquid dispensing and recirculating system comprising, a container (15) having a mouth (16), a cap (30)

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for coupling with the mouth, a connector for coupling with the cap (Col.4, Lns.36-39), the connector further comprising, a connector head (28), and a probe (32) extending from the connector head and insertable through the cap and into the mouth, the probe having a flow passage therein which terminates near a probe tip, a pump (Col. 3, Lns. 14-19) coupled with the probe and with the flow passage for pumping fluid in the container through the probe and the flow passage, and a fluid channel (below 55) extending longitudinally along an exterior of the probe adapted to return recirculated fluid to the fluid in the container such that air in the recirculated fluid is released from the fluid return channel before reaching the fluid in the container to prevent injection of air into the fluid in the container and wherein the fluid return channel is adapted to return the liquid to liquid in the container such that air in the air in the returned liquid is released from the fluid return channel before reaching the liquid in the container to prevent injection of air into the liquid in the container (the air rises to the top of the container as the liquid is entering into the container along the channel) as shown in figure 1.

Regarding claim 2, Van den Bergen et al. disclose that the fluid return channel (below 55) is formed along an exterior of the probe from an area proximate to the connector head to an area proximate to the probe tip as shown in figure 1.

Regarding claim 4, Van den Bergen et al. disclose that the fluid channel has a uniform depth as shown in figure 1.

Regarding claim 5, Van den Bergen et al. disclose that the fluid channel extends along the probe substantially parallel with the flow passage as shown in figure 1.

Regarding claim 6, Van den Bergen et al. disclose that the fluid return return channel includes a bore (55) formed at the area proximate to the connector head for delivering the recirculated fluid to the fluid return channel as shown in figure 1.

Regarding claim 7, Van den Bergen et al. disclose that the bore is sized such that recirculated fluid remains within the fluid return channel as it is returned to the container as shown in figure 1.

Regarding claim 8, Van den Bergen et al. disclose that the cap includes a first key element and the connector includes a second key element configured to mate with the first key element (Col. 4, Lns. 55- Col. 5, Lns. 2, the handle and cam mate with surfaces 44 and 45) as shown in figures 1 and 3.

Regarding claims 9-12, Van den Bergen et al. disclose a sensor for sensing when the first and second key elements are mated and for sensing when the first and second key elements are not mated, and wherein the sensor comprises a detector mounted on the connector and a detector affecting element mounted on the cap, the detector mounted on the connector having two states, one state when the first and second key codes are mated and the cap and connector are coupled in a predetermined orientation and a second state when the first and second key codes are not mated and the cap and connector are not coupled in the predetermined orientation and wherein the sensor comprises a detector mounted on the cap and a detector affecting element mounted on the connector, the detector mounted on the cap having two states, one state when the first and second key codes are mated and the cap and connector are coupled in a predetermined orientation and a second state when the first

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and second key codes are not mated and the cap and connector are not coupled in the predetermined orientation and further comprising, a controller coupled with the sensor and the pump such that the controller enables the pump when the sensor senses that the first and second key elements are mated and disables the pump when the sensor senses that the first and second key elements are not mated (Col. 3, Lns. 41-65, and Col. 6, Lns. 7-10).

Regarding claim 16, Van den Bergen et al. disclose that the fluid return channel has a uniform depth as shown in figure 1.

Regarding method claims 17-20 and 22-24 the device shown by Van den Bergen et al. will perform the methods as recited in claims 17-20 and 22-24, during normal operational use of the device, the method of making or using the device is inherent in using the apparatus.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van den Bergen et al. '113 in view of Priebe et al. (US 2003/0075566).

Van den Bergen et al. has taught all of the features of the claimed invention although is silent to the device having a pressure assist port.

Priebe et al. disclose that the pressure assist port (Figure 4A) that is coupled to an external pressure source for introducing pressurized gas into the container to facilitate flow of the fluid from the container (Page 4, para.0067).

In view of the Priebe et al. patent, it would have been obvious to one of ordinary skill in the art at the time of invention to employ the external pressure source for introducing pressurized gas into the container to facilitate flow of the fluid from the container of Priebe et al. onto the device of Van den Bergen et al. in order to avoid contamination of the process liquid (para.0065).

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the



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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 8 of copending Application No. 10/247107 in view of Van den Bergen et al. '113.

Claim 1 of application 10/247107 shows all of the features of the claimed invention except the cap, and the pump. The connector and dip tube of application 10/247107 is seen as the same structure as the connector head and probe of the instant application. Van den Bergen et al. disclose a cap, a pump and a channel extending longitudinally along an exterior of the probe. It would have been obvious to provide a cap and a pump to move fluid.

The limitations from claim 13 are present in claim 8 of '107.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

8. Applicant's arguments filed on 5 October 2006 have been fully considered but they are not persuasive.

In your argument regarding that "air in the refilled fluid is released from the fluid return channel before reaching the fluid in the container to prevent injection of air into the fluid in the container," occurs when the fluid enters the channel, the air releases from the fluid and rises to the top portion of the container prior to the fluid that enters the container contacting with the fluid in the container.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig Price whose telephone number is (571) 272-2712. The examiner can normally be reached on 7AM - 5:30PM M-R.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Keasel can be reached on (571) 272-4929. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CP



27 November 2006



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